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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,727

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Julia Ruth Dean

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EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

NOTIFICATION DATE

DELIVERY MODE

12/23/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com
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Office Action Summary	Application No.	Applicant(s)	
	10/576,727	DEAN, JULIA RUTH	
	Examiner	Art Unit	
	Kyle Grabowski	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-36 and 38-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10, 12-32, 38-42 and 44-47 is/are allowed.
- 6) ☒ Claim(s) 33-36 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3725

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 33-36 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe (US 4,307,899) in view of Howland et al. (US 6,089,614) and *Understanding Halftones*.

4. In respect to 33, 35-36, and 43, Hoppe discloses a document or article carrying a security device provided on a substrate, comprising: at least one printed or transferred first area 11, each first area having at least one first color (red); at least one printed or transferred second area 12 (having the color white of printed layer 4) on the same side

Art Unit: 3725

of the substrate as the first area, and wherein the first area 11 surrounds the second area 12, each first area being distinguishable from the second area, the first area defining a border of the second area, and wherein at least first area and the second area defines an image "7"; and a camouflage color ("reflective media") 8 provided over the image and at least an adjacent region surrounding the image on the same side of the substrate the camouflage pattern having a color (white) such that in combination with the first and second areas, the camouflage pattern renders the image substantially invisible when viewed under reflected light but visible when viewed in transmission (Abstract, Fig. 2a/b).

5. Although Hoppe discloses the a camouflage color, he does not disclose a pattern, for example a demetallized pattern, however Howland teaches a very similar invention wherein a camouflage layer 10 obscures underlying indicia in reflected light in a similar manner; the camouflage layer may comprise a highly reflective discontinuous (e.g. constituting a 'pattern') metal (Col. 7, 49 – Col. 8, 7) and It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the white print camouflage pattern taught in Hoppe with a partially metalized camouflage layer taught in Howland et al. The substitution would not destroy either invention, in fact, Howland et al. also discloses a pearlescent white camouflage (similar to Hoppe) as equally permissible. In both cases the camouflage is reflective, hiding underlying indicia, but permissive to transmissive light. Substituting the white ink layer for a demetallized layer would in Hoppe would not alter or destroy the invention, and

Art Unit: 3725

would predicatively serve an identical function. A fine array of dots may be considered a “line pattern”. (Col. 8, 5-7).

6. Hoppe discloses an offset printing process (Col. 3, 3-5) and that any number of colors (Col. 5, 27-31) may be used for the areas but does not explicitly disclose that at least one of the first and second areas comprises a discontinuous pattern. Inherent in an offset process however is a series of halftones (regularly spaced circular dots, also forming “fine lines”) that in all but a few basic cases (pure magenta) result in a discontinuous pattern (e.g. lighter shades of red resulting from varying degrees of underlying paper or black halftones for darker shades). In any case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a colored area on the security feature disclosed in Hoppe with a discontinuous pattern (e.g. pink; a red discontinuous halftone pattern) as the first area (or second area) in view of *Understanding Halftones*. The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary common sense. The properties of offset printing and their intrinsic halftones are known as taught in *Understanding Halftones*.

7. In respect to claim 34, Hoppe discloses that the first and second areas may be overprinted with an image 9 (also “7”) in white ink (Fig. 2a).

8. In respect to the newly amended subject matter of claims 33 and 43, Hoppe does not disclose “printed metallic inks” however while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be

Art Unit: 3725

distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997). (MPEP 2114). A sputtered metal coating and a printed metal ink result in structural equivalents as broadly claimed.

Allowable Subject Matter

9. Claims 1-10, 12-32, and 38-42, are allowed.

10. None of the cited prior art anticipates or renders obvious all of the claimed subject matter of independent claims 1, 38, or 41, namely, “wherein, elements of the camouflage pattern and background areas between elements of the discontinuous pattern are approximately a same size, or the elements of the camouflage pattern are of a similar size to the elements of the discontinuous pattern.” Hoppe and Howland et al. substantially disclose the subject matter, but not matters of the camouflage pattern having elements of a particular size, especially a size corresponding to elements of the discontinuous pattern that it covers.

Response to Arguments

11. Applicant's arguments filed 11/29/10 have been fully considered but they are not persuasive. The applicant contends that Howland teaches away from Hoppe, namely because Hoppe allegedly only teaches generating colors under different types of light,

Art Unit: 3725

while Howland discloses a reflective media to control the visibility of indicia, however the examiner respectfully disagrees. As stated in the action, Hoppe discloses a reflective media 8, which is a white layer that blocks underlying color, (effectively the same controlling the visibility underneath) (Col. 4, 53-54), and thus substituting this layer with a metallic reflective media (taught by Howland) would produce predictable results, namely, controlling the visibility of underlying indicia.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3725

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, 9am - 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725